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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/671,692 | 09/29/2003 | Samuel H. Mallicoat | | 7409 |

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EXAMINER

SAKRAN, VICTOR N

ART UNIT PAPER NUMBER

3677

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,692

Applicant(s)

MALLICOAT, SAMUEL H.

Examiner

VICTOR N SAKRAN

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Thamm U. S. Patent No. 1,329,149; see Figures 1-4; page 1, lines 24-29 and lines 41-49.

Claims 1 and 2, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Basseches et al U. S. Patent No. 4,425,680; see Figures 2-4; column 1, lines 40-43, 59-65, and claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, are rejected under 35 U.S.C. 103(a) as being unpatentable over Basseches et al U. S. Patent No. 4,425,680.

Basseches et al discloses Applicant's claimed combination of a single-piece napkin clip holder molded of a resilient plastic material such as polymeric material as a unitary element, wherein said clip having a front face (16) provided with projection portion at each end of said front face (16) defining an area for

receiving an indicia means such as an advertising slogan or the like; see Figure 4, column 1, lines 59-62.

Claims 1-3, are further rejected under 35 U.S.C. 103(a) as being unpatentable over Basseches et al '680 in view of Anderson U. S. Patent No. 2,171,350.

Basseches et al discloses Applicant's claimed combination of a single-piece napkin clip holder molded of a resilient plastic material such as polymeric material as a unitary element, wherein said clip having a front face (16) provided with projection portion at each end of said front face (16) defining an area for receiving an indicia means such as an advertising slogan or the like; see Figure 4, column 1, lines 59-62, except that the reference to Basseches et al does not define the front face (16) of its clip as grooves to accommodate a card with printed matter. Anderson teaches the use of a clip having a front face provided with bent portions (21, 22) defining grooves for accommodating a card of printed graphic matter; see Figures 1-4; page 1, column 1, lines 42-49 and page 1, column 2, lines 43-50. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the projection portions which are formed at free ends of the front face in Basseches et al with a bent portions to define grooves for accommodating a card of printed graphic matter in the manner taught, disclosed and suggested by Anderson, especially, since such modification involves only routine skill in the art.

Claims 1 and 4, are rejected under 35 U.S.C. 103(a) as being unpatentable over Thamm U. S. Patent No. 1,329,149 in view of Hart U. S. Patent No. 2,247,372.

Thamm discloses Applicant's claimed of a single-piece napkin clip with a spring action for mounting the hook portion of its clip to a vest or the like of a user; see Figures 1-4; page 1, lines 24-29 and lines 41-49, except that the reference to Thamm does not disclose a notch for receiving a garment button. Hart teaches the use of a notch (5, 5a) for receiving a garment button in a napkin holder clip; see Figures 3, 5; Page 1, column 2, lines 25-32. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the hook (1) in the napkin clip in Thamm with a notch for receiving a garment button in order to secure the napkin clip to the vest or the like of a user in the manner taught, disclosed and suggested by Hart, especially, since the use of a notch to receive a garment button is conventional and well known within the art.

Furthermore, Applicant is reminded that in considering the disclosure of a reference, it is proper to take into account not only specific teaching of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom; see *In re Preda*, 401 F2d 825, 826, 159 USPQ 342,344 (CCPA1968).

Furthermore, the particular type of material used is to form the napkin clip is considered to be no more than an obvious matter of design choice within the skill

in the art, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. See In Re Leshin, 125 USPQ 416.

The use of a plurality of references is justified since some of the limitations to which they are applied are independent of each other; see Ex Parte Fine 1927 C. D. 84; O. G. 511 .


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant's attention is directed to the art cited herein, as showing structure related to Applicant's disclosed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR N SAKRAN whose telephone number is 703-308-2224. The examiner can normally be reached on 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. swann can be reached on 703-308-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 23, 2004


VICTOR N SAKRAN
Primary Examiner
Art Unit 3677